UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,968	04/25/2001	Dirk Husemann	CH9-2000-0021	9793

33360 7590 11/20/2006	EXAMINER
MARK D. MCSWAIN	GART, MATTHEW S

ART UNIT	PAPER NUMBER
3625	

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DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/843,968	HUSEMANN ET AL.
	Examiner	Art Unit	
	Matthew S. Gart	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 October 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-8,12,13,15,19-27,42 and 43* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-8, 12, 13, 15, 19-27 and 42-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Prosecution History Summary

- Claims 1-3, 9-11, 14, 16-18 and 28-41 have been cancelled.

- Claims 4-8, 12-13, 15, 19-27 and 42-43 are currently pending in the instant

application.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Response to Amendment

The amendment to the claims filed on 10/03/2006 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 43 is rejected under 35 U.S.C. 101.

<u>Referring to claim 43</u>. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. <u>Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function</u>

of the descriptive material to be realized. Claim 43 fails to recite a computer program

that is executable and is positively embodied on a computer-readable medium. The

claim is merely directed to a computer program per se.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-8, 12-13, 15, 19-27 and 42-43 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Glikman (Patent Application Publication 2001/0037254)

in view of Koren (Patent Publication 2003/0069844).

Referring to claim 4. Glikman discloses a method for handling by a mobile phone

carrier system a payment process for a customer who ordered a deliverable through a

merchant system at a certain price, the customer having access to a customer system

and a mobile phone with an associated phone number the mobile phone carrier system,

the method comprising:

- Obtaining transaction information for the ordering of the deliverable from the

    merchant system (Glikman: at least paragraph 40, "According to the present

    invention, a customer uses a customer device **100**, such as a personal computer,

    to access the vendor device **300**, such as a web server hosting the vendor's web

    site, through the network **200**, such as the Internet.");

- Obtaining the phone number of the mobile phone (Glikman: at least paragraph

    0040, "The processing device **400** generates a web page, which prompts the

    customer for information on the mobile device **600**.");

- Sending an order confirmation for the deliverable to the mobile phone using the phone number (Glikman: at least paragraph 0040, "Once the customer enters this information, the processing device **400** sends the purchase amount in a message to the mobile phone through the carrier network **500**.");

- Receiving through the mobile phone an order confirmation for the deliverable (Glikman: at least paragraph 0040, "The user of the mobile phone is prompted to confirm the purchase amount and if confirmed, the purchase amount is charged to the mobile account associated with the mobile device **600**");

- Charging the said certain price to a mobile phone bill identified to the mobile phone, said mobile phone bill maintained by the mobile phone carrier system for the mobile phone; and sending an order confirmation or payment confirmation back to the merchant system (Glikman: at least Abstract).

Gilkman does not expressly disclose identifying the mobile phone by caller ID in said charging step. Koren teaches a transaction handling method wherein caller ID identifies a mobile phone for transactional purposes. At the time of invention it would have been obvious for one skill in the art to have modified the method of Gilkman to have included the caller ID identification teachings of Koren because as taught by Koren in paragraph 0005 sometimes executing a transaction using a computer network such as the Internet is not optimal.

Furthermore, Gilkman does not expressly discloses a method for handling by a mobile phone carrier system a payment process for a customer who ordered a

deliverable through a merchant system at a certain price, the customer having access to

a customer system and a mobile phone with an associated phone number the mobile

phone carrier system, the method comprising:

- Storing open transactions in a database indexed by customer telephone numbers

  for subsequent matching of open transactions with customer telephone numbers

  upon order confirmation; and

- Determining a customer's telephone number by caller ID, comparing customer

  telephone numbers with customer telephone numbers indexing the database of

  open transactions, and if the customer's telephone number matches an entry in

  the database, deeming the order completed and initiating payment processing.

Koren discloses a method, the method comprising:

- Storing open transactions in a database indexed by customer telephone numbers

  for subsequent matching of open transactions with customer telephone numbers

  upon order confirmation (Koren: at least paragraph 0026); and

- Determining a customer's telephone number by caller ID, comparing customer

  telephone numbers with customer telephone numbers indexing the database of

  open transactions, and if the customer's telephone number matches an entry in

  the database, deeming the order completed and initiating payment processing

  (Koren: at least paragraph 0026).

At the time of invention it would have been obvious for one skill in the art to have

modified the method of Gilkman to have included the teachings of Koren because the

number of simultaneous transactions a vendor using a human-operated call center can handle is limited by the number of agents and by the relatively long duration of human telephone conversations between agents and users (Koren: paragraph 0010).

Referring to claim 5. Glikman further discloses a method wherein the merchant system offers an online catalog with a plurality of deliverables for selection by the customer (Glikman: at least Fig. 12, "**720**" "**730**" and "**740**").

Referring to claim 6. Glikman further discloses a method comprising a checkout step after the step of performing an action on the customer system in order to select the deliverable (Glikman: at least Fig. 12, "**750**").

Referring to claim 7. Gilkman further discloses a method comprising sending the phone number of the mobile phone from the customer system or the mobile phone to the merchant system; storing the phone number at the merchant system (Glikman: at least paragraph 0040).

Referring to claim 8. Glikman discloses a method comprising the steps: receiving the phone number of the mobile phone from the customer system or the mobile phone; storing the phone number at the merchant system (Glikman: at least paragraph 0040).

Referring to claim 12. Glikman further discloses a method wherein the customer performs an action on the mobile phone in order to confirm the ordering of the deliverable (Glikman: at least paragraph 0040).

Referring to claim 13. Glikman further discloses a method wherein the mobile phone prompts the customer for a personal identification number for authentication purposes (Glikman: at least paragraph 0060).

Referring to claim 15. Glikman further discloses a method wherein the step of sending an order confirmation for the deliverable to the mobile phone is done using the push feature of the wireless application protocol (WAP) in order to push a wireless markup language (WML) script applet to the mobile phone (Glikman: at least paragraph 0043).

Referring to claim 19. Glikman further discloses a method wherein the phone bill is either delivered to the customer through a conventional distribution channel, by mail, or to the customer system through a communication network (Glikman: at least paragraph 0018).

Referring to claim 20. Glikman discloses a merchant system for offering a deliverable via a network to a potential customer using a customer system and a mobile phone connected to a mobile phone carrier network, comprising:

- A network interface connectable to the network (Glikman: at least Fig. 1, "**500**")

- A processing unit (Glikman: at least Fig. 1, "**400**");

- A database for maintaining detailed information about the deliverable (Glikman: at least Fig. 8, "**320**");

- A module for making the deliverable and some or all of the detailed information about the deliverable displayable to the potential customer on the customer system (Glikman: at least paragraph 0040);

- A module for making the deliverable selectable by the potential customer on the customer system (Glikman: at least paragraph 0040);

- A module for receiving an order for the deliverable from the customer system via the network and network interface (Glikman: at least paragraph 0040);

- A module for causing a confirmation to be transmitted to the mobile phone through the mobile telephone network (Glikman: at least paragraph 0040);

- A module for receiving an order confirmation issued by the module device, or a payment confirmation issued by a carrier system (Glikman: at least paragraph 0040);

- A module for making the deliverable available to the customer (Glikman: at least paragraph 0040).

Gilkman does not expressly disclose a module storing open transactions in a database indexed by customer telephone numbers for subsequent matching of open transactions with customer telephone numbers upon order confirmation, determining a customer's telephone number by caller ID, comparing customer telephone numbers with

the customer telephone number indexing the database of open transactions, and if the

customer's telephone number matches an entry in the database, deeming the order

completed and initiating payment processing of a mobile telephone account identified by

the caller ID of the order confirmation.

Koren discloses a module storing open transactions in a database indexed by

customer telephone numbers for subsequent matching of open transactions with

customer telephone numbers upon order confirmation, determining a customer's

telephone number by caller ID, comparing customer telephone numbers with the

customer telephone number indexing the database of open transactions, and if the

customer's telephone number matches an entry in the database, deeming the order

completed and initiating payment processing of a mobile telephone account identified by

the caller ID of the order confirmation (Koren: at least paragraph 0026).

At the time of invention it would have been obvious for one skill in the art to have

modified the method of Gilkman to have included the teachings of Koren because the

number of simultaneous transactions a vendor using a human-operated call center can

handle is limited by the number of agents and by the relatively long duration of human

telephone conversations between agents and users (Koren: paragraph 0010).

Referring to claim 21. Glikman further discloses a merchant system whereby

some or all of the modules are realized in form of software modules that, when

executed by the processing unit, provides the modules functionality (Glikman: at least

paragraphs 0042 and 0046).

Referring to claim 22. Glikman further discloses a merchant system comprising a call-in unit connectable to the mobile telephone network (Glikman: at least paragraph 0040, "The customer may be asked for information, such as a unique subscriber identification number and/or the name of the carrier associated with the mobile phone. Once the customer enters this information, the processing device **400** sends the purchase amount <u>in a message to the mobile phone</u> through the carrier network **500**. The user of the mobile phone is prompted to confirm the purchase amount and if confirmed, the purchase amount is charged to the mobile account associated with the mobile device **600**. At the same time, the customer is presented with a web page displayed on the customer device **100** notifying the customer of the status of the transaction.").

Referring to claim 23. Glikman further discloses a merchant system whereby a special call-in is assigned to the call-in unit so that the call-in unit is reachable from the mobile phone through the mobile telephone carrier system when dialing the call-in number (Glikman: at least paragraph 0040, "The customer may be asked for information, such as a unique subscriber identification number and/or the name of the carrier associated with the mobile phone. Once the customer enters this information, the processing device **400** sends the purchase amount <u>in a message to the mobile phone</u> through the carrier network **500**. The user of the mobile phone is prompted to confirm the purchase amount and if confirmed, the purchase amount is charged to the mobile account associated with the mobile device **600**. At the same time, the customer is

presented with a web page displayed on the customer device **100** notifying the

customer of the status of the transaction.").

Referring to claim 24. Glikman further discloses a merchant system whereby the

processing unit resides in a computer system (Glikman: at least Fig. 6, "**400**").

Referring to claim 25. Glikman further discloses a merchant system whereby the

module for making the deliverable and some or all of the detailed information about the

deliverable displayable is an online-catalogue module (Glikman: at least Fig. 12, "**720**"

"**730**" and "**740**").

Referring to claim 26. Glikman further discloses a merchant system whereby the

module for making the deliverable available to the customer either causes the

deliverable to be delivered via a conventional distribution channel, or whereby the

module causes the deliverable to be delivered via a communication link to the customer

system, or whereby the module causes the deliverable to be made downloadable

through a communication link (Glikman: at least abstract).

Referring to claim 27. Glikman further discloses a merchant system whereby the

confirmation address is a call-in number or an e-mail address (Glikman: at least

paragraph 0040, "The customer may be asked for information, such as a unique

subscriber identification number and/or the name of the carrier associated with the

mobile phone. Once the customer enters this information, the processing device **400**

sends the purchase amount <u>in a message to the mobile phone</u> through the carrier

network **500**. The user of the mobile phone is prompted to confirm the purchase amount

and if confirmed, the purchase amount is charged to the mobile account associated with

the mobile device **600**. At the same time, the customer is presented with a web page

displayed on the customer device **100** notifying the customer of the status of the

transaction.").

<u>Referring to claims 42 and 43</u>. The computer program product of claim 42 and

the computer program element of claim 43 are rejected under the same rationale as set

forth above.

Response to Arguments

Applicant's arguments with respect to all the pending claim have been considered but are moot in view of the new ground(s) of rejection.

Examiner's Comments

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

MSG
Primary Examiner
November 13, 2006